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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/675,003	09/30/2003	John R. Fyson	83645BF-P	5199

7590 07/06/2004

Patent Legal Staff
Eastman Kodak Company
343 State Street
Rochester, NY 14650-2201

EXAMINER

LE, HOA VAN

ART UNIT	PAPER NUMBER
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1752

DATE MAILED: 07/06/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/675,003	Applicant(s) FYSON ET AL.	
	Examiner Hoa V. Le	Art Unit 1752	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-6 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) ____ is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>30 September 2003</u> . | 6) <input type="checkbox"/> Other: ____. |

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This application is division of application no. 10/341,662 and is before the examiner for consideration on the merits.

I. The record shows that applicants fail to provide any test as set for on the record in the parent application no. 10/341,662. (1) It is conventional or well known in the art to include a sufficient and effective amount of an optical brightener to match a possible stain and/or to provide a sufficient and effective brightening result on a processed photographic material that could be detected and pleased by an average consumer. (2) It is also conventional and well known in the art that a processed photographic is intended to be seen. However, the counsel for Eastman Kodak Company states on the record that the Kodak processed products as made by the applied O'Toole et al (5,508,151) on the record is not detectable or able to be seen any brightening result without any convincing evidence to support. In the absence of convincing evidence, the claims may have and be given no value if an evidence may be later tested, found, shown or provided that an average consumer would be able to distinct O'Toole et al processed material with respect to brightening result from one being processing with no optical brightener.

II. Claim 5 contains the trademark/trade name "Phorwrite". Where a trademark or trade name is used in a claim as a limitation to identify or describe a particular material or product, the claim does not comply with the requirements of 35 U.S.C. 112, second paragraph. See *Ex parte Simpson*, 218 USPQ 1020 (Bd. App. 1982). The claim scope is uncertain since the trademark or trade name cannot be used properly to identify any particular material or product. A trademark

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or trade name is used to identify a source of goods, and not the goods themselves. Thus, a trademark or trade name does not identify or describe the goods associated with the trademark or trade name. In the present case, the trademark/trade name is used to identify/describe a fluorescent and, accordingly, the identification/description is indefinite.

III. A. (1) It is allowed to claim by a functional, characteristic, conditional, physical and/or chemical property of a material and /or process. (2) However, a claimed functional, characteristic, conditional, physical and/or chemical property of a material and/or process carries with a risk (In re In re Schreiber, 44 USPQ2d 1432). It is reasonable that the Office is not supplied, provided or equipped with a sufficient facility to carry out a test for the functional, characteristic, physical and/or chemical properties as claimed in accordance with the authority stated in In re Best, 195 USPQ 430; Ex parte Maizel, 27 USPQ2d 1662 or Ex parte Phillip, 28 USPQ2d 1302. The language “chemical compound that is...has taken place”, “chemical compounds absorb UV...in the visible spectrum”, “optical brightener” or the like is considered as the property of a material. It is considered and searched as appeared.

(B) In re Schreiber, 44 USPQ2d 1429 state that “A patent applicant is free to recite features of an apparatus either structurally or functionally. See In re Swinehart...169 USPQ 226, 228... Yet, choosing to define an element functionally, i.e., by what it does, carries with a risk. As our predecessor court state in Swinehart...where the Patent Office has reasons that the functional limitation asserted to be critical for establishing novelty in the claimed subject mater may, in fact, be an inherent characteristic of the prior art, it possesses the authority to require the applicant to prove that the subject matter shown to be in the prior art does not possess the characteristic relied on.” An argument alone may has and be given a little to no value. A claim

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would have no value, if an inherent or closely inherent property as found, shown or provided from a piece of a prior art. It is notified for the record.

IV. Claims 1-6 are rejected under 35 U.S.C. 103(a) as being unpatentable over Goswami et al (6,153,365).

(1) It is conventional or well known in the art to include a sufficient and effective amount of an optical brightener to match a possible stain and/or to provide a sufficient and effective brightening result on a processed photographic material that could be detected and pleased by an average consumer.

(2) It is also conventional and well known in the art that a processed photographic is intended to be seen. An optical brightening result is also detected and identified. Evidence can be seen in Goswami et al. Please see the whole disclosure of the applied reference, especially at compounds 1-17, Table 1 and Examples. The language "chemical compound that is...has taken place", "chemical compounds absorb UV...in the visible spectrum", "optical brightener" or the like is considered as the property of a material. The law requires that applicants must show or provide a convincing evidence that a brightening result of the use of a conventional or sufficient amount of a brightening agent in the Kodak processed photographic products as processed and made by the applied Goswami et al is not detectable or identifiable by either an average skilled worker in a photographic art or average consumer or both of them as compared to the one that being processed with no optical brightening agent for a patentability of the claims to speed up the prosecution to avoid any further work that may be later required. In the absence of convincing evidence as required by law as clearly pointed out and set forth on the record in paragraph "III"

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above, the above claims are not allowable over the applied Goswami et al for the use of a reasonably inherent property of the same or substantially the same brightening compound to one skilled in the art. Applicants should show an evidence to the contrary.

V. Claims 1-4 and 6 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kamada et al (5,534,395).

(1) It is conventional or well known in the art to include a sufficient and effective amount of an optical brightener to match a possible stain and/or to provide a sufficient and effective brightening result on a processed photographic material that could be detected and pleased by an average consumer.

(2) It is also conventional and well known in the art that a processed photographic is intended to be seen. An optical brightening result is also detected and identified by an instrument. Evidence can be seen in Kamada et al. Please see the whole disclosure of the applied reference, especially at col.16:19 to 23:30, 68:24-26, Example 2 at Table 14, 87:8-24, 103:32-58. The language "chemical compound that is...has taken place", "chemical compounds absorb UV...in the visible spectrum", "optical brightener" or the like is considered as the property of a material. The law requires that applicants must show or provide a convincing evidence that a brightening result of the use of a conventional or sufficient amount of a brightening agent in the Kamada et al processed photographic products is not detectable or identifiable by either an average skilled worker in a photographic art or average consumer or both of them as compared to the one that being processed with no optical brightening agent for a patentability of the claims to speed up the prosecution to avoid any further work that may be later required. In the absence of

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convincing evidence as required by law as clearly pointed out and set forth on the record in paragraph "III" above, the above claims are not allowable over the applied Goswami et al for the use of a reasonably inherent property of the same or substantially the same brightening compound to one skilled in the art. Applicants should show an evidence to the contrary.

VI. Claims 1-4 and 6 are rejected under 35 U.S.C. 103(a) as being unpatentable over Nakai et al (6,632,594).

(1) It is conventional or well known in the art to include a sufficient and effective amount of an optical brightener to match a possible stain and/or to provide a sufficient and effective brightening result on a processed photographic material that could be detected and pleased by an average consumer.

(2) It is also conventional and well known in the art that a processed photographic is intended to be seen. An optical brightening result is also detected and identified an instrument. Evidence can be seen in Nakai et al. Please see the whole disclosure of the applied reference, especially at the general formulas I and II, compounds on col.4:35-64, compounds on 5:1-29, compounds I(1-48) and II(1-16), 38:60-65, Examples. "chemical compound that is...has taken place", "chemical compounds absorb UV...in the visible spectrum", "optical brightener" or the like is considered as the property of a material. The law requires that applicants must show or provide a convincing evidence that a brightening result of the use of a conventional or sufficient amount of a brightening agent in Nakai et al processed photographic products is not detectable or identifiable by either an average skilled worker in a photographic art or average consumer or both of them as compared to the one that being processed with no optical brightening agent for a

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patentability of the claims to speed up the prosecution to avoid any further work that may be later required. In the absence of convincing evidence as required by law as clearly pointed out and set forth on the record in paragraph "III" above, the above claims are not allowable over the applied Goswami et al for the use of a reasonably inherent property of the same or substantially the same brightening compound to one skilled in the art. Applicants should show an evidence to the contrary.

VII. Nakai et al (6,605,420) and all (1) liquid processed photographic material containing a brightening agent and (2) photographic material being processed in a liquid containing an optical brightening agent will be next in line to be applied for applicants to test for their property a broadly claimed. A set of least three references will be applied a time when all of the above applied references are tested and overcome. It is now notified for the record.

VII. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Hoa V. Le whose telephone number is 571-272-1332.

The examiner can normally be reached from 6:30 AM to 4:30 PM on Monday through Thursday and about the same time of most Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mark F. Huff can be reached on 571-272-1385.

Applicants may file a paper by (1) fax with a central facsimile receiving number 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Hoa V. Le
Primary Examiner
Art Unit 1752

HVL
28 June 2004

HOA VAN LE
PRIMARY EXAMINER

A handwritten signature in black ink that reads "Hoa Van Le". The signature is written in a cursive, flowing style.